IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	Wallace, et al.	Confirmation No. 3557
Serial No.:	10/066,144	Examiner: Namitha Pillai
Filed:	January 31, 2002	Group Art Unit: 2173
For:	ANIMATED SCREEN OBJECT FOR ANNOTATION AND SELECTION OF VIDEO SEQUENCES	

MAIL STOP Appeal Brief – Patents
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REPLY BRIEF
UNDER 37 C.F.R. § 41.41

In the Examiner's Answer to the Appeal Brief filed February 28, 2006, the Examiner has repeated the arguments in support of his earlier final rejection of the claims and has responded specifically to Appellants' arguments presented in the Appeal Brief. Because the Examiner has stated additional grounds for each of these arguments, Appellants feel that a reply is necessary to address these grounds in turn.

A. The Examiner Has Mischaracterized Appellant's Arguments As A "Focus Point" Rather Than "Focus Position."

Whereas Appellant has used the term "focus position" consistently within the specification and claims of the pending application, the Examiner's Answer has now mischaracterized the limitation as a "focus point," stating the following:

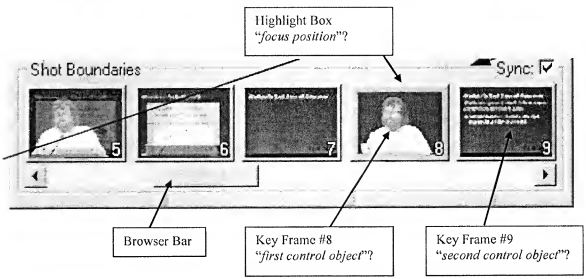
> Appellant's arguments discusses a focus point where focus point has been interpreted by the Examiner as a point on the screen that has brought some type of focus or attention to it. The shot frame that is currently highlighted is interpreted as the focus point, where the currently highlighted frame is at focus and corresponds with the video data being played simultaneously. (Examiner's Answer, p. 8 (emphasis added))

Appellants have conducted a word search on their own specification, on their prosecution documents (*e.g.,* responses to Office Actions), and their Appeal Brief and can find no mention of the term "focus point." Such a term has been fabricated by the Examiner with the effect of misrepresenting the actual claim limitation term "focus position."

B. The Examiner Is In Error By Interpreting The "Focus Position" Language So Broadly As To Encompass The Li Prior Art.

Case law is fairly specific on how claim language is to be interpreted during prosecution. "Words in a claim are generally given their ordinary and accustomed meaning unless the inventor chooses to be his own lexicographer in the specification." *Lantech, Inc. v. Keip Mach. Co.*, 32 F.3d 542, 547, 31 USPQ2d 1666, 1670 (Fed. Cir. 1994). "In examining a patent claim, the PTO must apply the broadest reasonable meaning to the claim language, taking into account any definitions presented in the specification." *In re Yamamoto*, 740 F.2d 1569, 1571, 222 USPQ 934, 936 (Fed. Cir. 1984). The Federal Circuit cautions, however, that the PTO is not to erroneously construe the claims (as was the case in *Baker Hughes*) where such construction was "beyond that which was reasonable in light of the totality of the written description." *In re Baker Hughes, Inc.*, 215 F.3d 1297, 55 USPQ2d 1149 (Fed. Cir. 2000).

The Figure below is taken from the Li reference with text box labels attached by Appellants to indicate the Examiner's association of Li items with those claimed in the present application. These elements include: (1) first control object, (2) focus position, and (3) second control object. Claim 1 is a method claim that dictates the interactions of these various elements:



The highlight box around key frame #8 indicates that the video segment associated with key frame #8 is currently being played in a video window. When the video segment ends, the highlight box moves to surround key frame #9 in substantial synchronicity with the highlight moving (*e.g.*, "focus position") moving.

The action gerund verb in appealed claim 1 cites "moving the second control object to the focus position." The generally accepted definition of "moving" is "to change in position from one point to another." It is therefore the second control object element which will move according to the explicit, or even any reasonably broad, definition of the claim limitation – movement of the focus position element is not called for.

The "second control object" in Li can only be interpreted as key frame #9 in the figure above. In Li, therefore, the second control object is stationary as the highlight box moves. That is, a transition from one video segment to the next in Li on causes the highlight box to move, not the key frame. Accordingly:

Present Invention Limitation	Li Teaching
"moving the second control object"	"moving the focus position (*e.g.*, highlight box)"

The above analysis illustrates that the Examiner has committed the same error as noted in the *Baker Hughes* case by applying a definition to "focus position" that is beyond that which is reasonable in light of the totality of the written description. For instance, the Examiner is confusing "the highlighted frame" (apparently the frame placed around the keyframe to show its "focus"), with "control objects" of the claims. Whereas the highlighted frame moves from keyframe to keyframe as the video transitions between segments, the keyframes themselves do not move without a user scrolling between them. In other words, the moving keyframes (*e.g.*, "control objects associated with a video segment") do not move in substantial synchronicity with a transition between video segments as required under the claims and therefore there can be no anticipation and rejection under 35 U.S.C. §102(a).

C. The Examiner Reads Language That Is Not In The Claims

The Examiner imputes certain claim limitations that are not included within the claims:

- "focus point" – discussed in Section A
- "focus position changes"
- "highlighting frame would move"

The Examiner appears to have correctly characterized the Li reference as resulting in a highlighting frame that moves, stating:

> Li clearly teaches presenting the highlighted frame as the focus position in association with the currently playing video data, teaching a traversal method through which the highlighting frame would move to ensure that the currently highlighted frame corresponds with the currently played video data. Li teaches that as the video is playing, highlighting the frame associated with the currently playing video data, the focus position would change as the frame that is highlighted from the current frame to the adjacent frame as the video is playing, teaching the transition of the focus position to the corresponding new frame as the video is playing.
> (Answer, page 8)

Li teaches, then, that the highlighting box moves. Li says nothing about a move of the frame/control object itself. It is important to compare the Examiner's own text with the explicit words of the claims:

Present Invention Limitation	Li Teaching
"moving the second control object to the focus position, and the first control object out of the focus position . . . ."	"the focus position would change . . . teaching the transition of the focus position to the corresponding new frame as the video is playing"

It appears, then, that Li teaches the direct opposite of that set forth within the claims of the presently appealed patent application.

The Examiner's loose interpretation of Li is further exemplified by the last paragraph of the Answer which states:

Examiner's Answer	Actual Li Operation
Li teaches a move allowing for the second object to brought to focus position. (page 9)	The second object is NOT "brought" to the focus position in Li. Instead, the focus position is "brought" (*e.g.,* moved) to the second object.
Therefore, the adjacent frame, which is then brought to focus, is brought to focus by a move to a focus position. (page 9)	The adjacent frame (*e.g.,* frame #9) does NOT move to a focus position in Li. Instead, the focus position (*e.g.* highlighting box) moves to the adjacent frame.

Examiner's Answer	Actual Li Operation
The highlight process carries out the move to a foeus position, . . .	Again, the Examiner is vague about the active "moving" limitation within the claim . . .
. . . therefore the second object is moved to a foeus position, through highlighting of the frame which represents the seeond object. (page 9)	There is no support for the Examiner's definition of the word "moved" to encompass simply a changed state; rather, the move is in a physical sense of a position on a display as is appropriate for a graphic user interface where position is important. As such, the word "position" is used within the claim limitation itself (*e.g.,* focus position, rather than foeus state or focus condition).

In summary, the primary inquiry in this Appeal should be whether the prior art asserted during prosecution ean reasonably be interpreted to teach the limitations set forth in the claims. It is Appellants assertion that the Examiner has, instead, given an unreasonably broad reading to the prior art, to the limitations presented within the claims, and has combined prior art without any regard to the non-operability of sueh a combination.

For the foregoing reasons, Appellant requests that the Board reverse the Examiner's rejeetions to Appellant's claims.

Respectfully submitted,

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